



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

McDonnell Boehnen Hulbert & Berghoff LLP
300 South Wacker Drive
Chicago IL 60606

MAILED

FEB 07 2011

OFFICE OF PETITIONS

In re Patent No. 7,517,886 :
Issue Date: April 14, 2009 :
Application No. 10/631,029 : **DECISION ON PETITION**
Filed: July 29, 2003 :
Attorney Docket No. 09-555-US :

This is a decision on the renewed petition for expungement of information, filed November 24, 2010, which is being treated as petitions under 37 CFR 1.182 to invalidate an assignment previously recorded against the above-identified application.

The renewed petition is **dismissed**. This is not a final agency action.

Petitioner indicates an assignment recorded on August 15, 2005 was erroneously filed for the above identified application and requests this assignment record be expunged from the file. Petitioner argues that expungement of the noted assignment would not affect the integrity of the assignment records because the erroneously recorded assignment was in fact a license agreement and license agreements are not assignments.

Petitioner's argument is not convincing as it based on the assumption that assignment and assignment records are one and the same. Assignment records are the records of assignment documents recorded. MPEP 313 states in part:

**313 [R-3] Recording of Licenses, Security Interests, and Other Documents
Other Than Assignments**

In addition to assignments and documents required to be recorded by Executive Order 9424, documents affecting title to a patent or application will be recorded in the Assignment Division of the United States Patent and Trademark Office (Office). Other documents not affecting title may be recorded at the discretion of the Director. 37 CFR 3.11(a).

Thus, some documents which relate to patents or applications will be recorded, although they do not constitute a transfer or change of title. Typical of these documents which are accepted for recording are license agreements and agreements which convey a security interest. Such documents are recorded in the public interest in order to give third parties

notification of equitable interests or other matters relevant to the ownership of a patent or application.


The recordation of a document is not a determination of the effect of the document on the chain of title. The determination of what, if any, effect a document has on title will be made by the Office at such times as ownership must be established to permit action to be taken by the Office in connection with a patent or an application. See MPEP § 324.

Clearly, documents which are not assignments per se and do not transfer or change title may be recorded as an assignment document. Specifically identified as a type of such document is a license agreement. Therefore, expunging a license agreement that was recorded and became part of the assignment record would affect the integrity of the assignment record. Such an expungement is not allowed.

Petitioner argues that allowing the license agreement to remain in the assignment record would not allow third parties to determine title to pending applications and issued patents. However, as noted in MPEP 313 above, such documents are recorded in the public interest in order to give third parties notification of **equitable interests or other matters relevant to ownership**. This goes beyond petitioner's limited scope of concern over **title** to applications and patent.

For the reasons presented, the petition is dismissed.

Telephone inquiries concerning this communication should be directed to Carl Friedman at (571)272-6842.



David Bucci
Petitions Examiner
Office of Petitions

cc: Klarquist Sparkman, LLP
One World Trade Center, Suite 1600
121S.W. Salmon Street
Portland, Oregon 97204